

REMARKS

Claims 1, 2, 6-9, 11-25, 33-39, 41 and 42 are rejected. Claims 26-28 and 43 are withdrawn from consideration. Claims 29-32 and 40 are objected to. Claims 1, 2, 6-9, 11-25, 33-39, 41 and 42 are presently pending in the application. Favorable reconsideration of the application in view of the following remarks is respectfully requested.

Rejection of Claims 1, 2, 6-9, 19-25, 34, 35 and 38 Under 35 U.S.C. §102(b):

The Examiner has rejected Claims 1, 2, 6-9, 19-25, 34, 35 and 38 under 35 U.S.C. §102(b) as being anticipated by Okumura et al. (5,360,780) for reasons of record and for reasons given below.

Okumura discloses an image-receiving sheet for thermal transfer printing comprising a substrate and an image-receiving layer disposed on said substrate, characterized in that said image-receiving layer contains thermoplastic resin fine particle aggregates.

The present invention relates to an inkjet recording element comprising a support and at least two ink receiving layers thereon, wherein the topmost of said at least two ink receiving layers comprises porous polyester particles, wherein at least 68% of said porous polyester particles have a diameter of less than 0.5 micrometers. These particles, when used in coatings provide enhancements in the gloss, ink dry time and dye retention of the coating.

A claim is anticipated under 102(a) only if each and every element as set forth in the claim is found, either expressly or inherently, in a single prior art reference. Verdegaal Bros. V. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The present invention claims an inkjet recording element comprising a support having thereon an ink receiving layer capable of accepting an inkjet image. Okumura fails to mention inkjet recording elements or ink receiving layers capable of accepting inkjet images, teaching instead thermal transfer printing elements.

The Examiner indicates that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art.

See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). A thermal transfer printing element is not capable of functioning as an inkjet receiving element. In an inkjet receiving element, the ink is in a carrier solvent which penetrates rapidly into the receiving layer. The colorant is carried by a solvent. In thermal transfer receiving elements, dye melts or diffuses into the receiver, but is not carried by a solvent. Ink carried by a solvent, when applied to a thermal receiving element does not wet the element properly and does not form the desired image (see Exhibits 2 and 3), especially as compared to an inkjet receiving element (Exhibit 1). The reverse is also true. An inkjet receiver printed with a thermal donor (Exhibit 5) does not produce the desirable image produced when a thermal donor is printed to a thermal receiver (Exhibit 4). Therefore, the receiving elements are not interchangeable and a thermal receiver is not capable of performing as an inkjet receiver. See attached Fourth Declaration of Landry-Coltrain and attached Exhibits 1-5. Therefore, the rejection should be withdrawn.

Rejection Of Claims 1, 2, 6-9, 11-25, 33-39, 41 and 42 Under 35 U.S.C.

§103(a):

The Examiner has rejected Claims 1, 2, 6-9, 11-25, 33-39, 41 and 42 under 35 U.S.C. §103(a) as being unpatentable over Okumura et al. (5,360,780) for reasons set forth above and for the following reasons, indicating that the relationship between particle size and gloss is well known in the art, making it obvious to one of ordinary skill in the art to determine the particle size of the thermoplastic particles in order to obtain desired gloss.

To establish a prima facia case of obviousness requires, first, there must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references (or references when combined) must teach or suggest all the claim limitations.

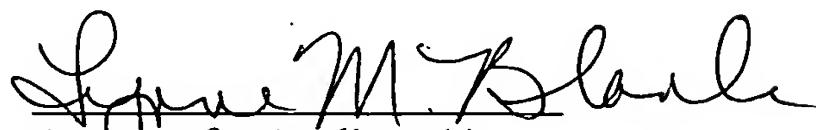
Okumura fails to mention the use of a distribution of particles of mean diameter less than 0.5 micrometers of which 68% of the particles have a diameter of less than 0.5 microns and fails to mention the use of these particles to enhance the gloss of a coated inkjet layer. In fact, Okumura teaches use of particles in a thermal transfer receiving sheet. Okumura also fails to produce a

reasonable expectation of success, as Okumura fails to mention that particles of size less than 0.5 micrometers prove useful in increasing gloss or providing an inkjet coating with increased gloss. It would not be obvious to one of ordinary skill in the art would recognize that the materials useful in thermal transfer receiving layers would function properly in inkjet layers, let alone improve the gloss. Finally, Okumura fails to teach all of the limitations of the present claims as it fails to teach or disclose the use of particles of less than 0.5 micrometers and fails to mention that in a distribution of particles of mean diameter less than 0.5 microns, more than 68% have a particle size of less than 0.5 microns to produce high gloss coatings. As a result, Okumura fails to support a *prima facia* case of obviousness under 35 U.S.C. 103(a).

The present invention also provides surprising results. Not only does the present invention improve the gloss, but it also improves ink dry time and dye retention at the same time it improves the gloss. See Table 5, pg. 28) While may be known in the art to improve gloss, dry time and dye retention individually, it is not known that the use of particles of less than 0.5 micrometers, or a in a distribution of particles of mean diameter less than 0.5 microns, more than 68% of which have a particle size of less than 0.5 microns produces high gloss coating, which exhibit improved ink dry time and dye retention. The ability to improve all three properties at once is surprising. In light of these surprising results, the Applicants request that the Examiner reconsider and withdraw the rejection.

It is believed that the foregoing is a complete response to the Office Action and that the claims are in condition for allowance. Favorable reconsideration and early passage to issue is therefore earnestly solicited.

Respectfully submitted,



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